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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,365	06/22/2001	Stephen DeOrnellas	TEGL-01092US1	8894

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EXAMINER

ALEJANDRO MULERO, LUZ L

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 03/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,365

Applicant(s)

DEORNELLAS ET AL.

Examiner

Luz L. Alejandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16, 19, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16, 19, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: in the section under "Cross Reference", it is necessary to update the status of the applications as to whether they have been abandoned or patented. If the applications have been patented, then the patent number should also be included.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14-line 2, the phrase "to about" (first occurrence) renders the claim unclear. It appears that a temperature range of 300 to 500 Celsius is being claimed. Suggested claim language is to replace "to about" (first occurrence) with -- from about--.

In claim 31-line 1, the use of the phrase "The reactor" renders the claim indefinite because claim 12 is a method claim. Suggested language is to replace "The reactor" with -- The method --.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 12-16, 19, and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 07-130712A.

JP 07-130712A shows the invention as claimed including introducing process gas into a reaction chamber 1 (see Fig. 1 and reference numeral 8); providing power to an electrode 2 using a RF source in order to facilitate a reaction with said process gas and a workpiece 6 contained in said reaction chamber; and heating the electrode with a heater 3 to a temperature which encourages the growth of a stable layer of material on said electrode (note that the abstract discloses heating at 350 Celsius and above, and the bottom of page 3 discloses 400 Celsius, both of which are within the claimed range of applicant).

With respect to claims 15-16 and 19, note from the abstract that the process is a platinum etch process and that the temperatures used would inherently de-sorb chlorine and oxygen from the electrode surface.

Claims 12-16, 19, and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by DeOrnellas et al., U.S. Patent 6,046,116.

DeOrnellas et al. shows the invention as claimed including a method of operating a reactor which comprises a reactor chamber 20 (see Fig. 7), an electrode 28, a heater 56 that heats said electrode 28 (see Fig. 8), and gas inlets and outlets, the method comprising: introducing process gas into said reactor chamber 20; providing power to said electrode using power supplies 34 and 36 (see col. 3-lines 18-35) in order to facilitate a reaction with said process gas and a workpiece contained in said reaction chamber; and heating the electrode with said heater (see col. 3-lines 49-55) to a temperature which encourages the growth of a stable layer of material on said electrode (see col. 4-line 64 to col. 5-line 13).

Regarding claim 14, the heating process attains a heating temperature of 300 Celsius (see col. 4-lines 15-19).

With respect to claims 15-16, a platinum etch method is clearly disclosed (see col. 5-lines 1-13).

Furthermore, regarding claim 19, DeOrnellas et al. clearly discloses that performing the platinum etching at elevated temperatures causes oxygen and chlorine to de-sorb from the electrode (see col.5-lines 10-13).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-16, 19, and 30-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S.


Patent No. 6,046,116. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the patent are more narrow than the claims of the application with the exception of the temperature range claimed in the application, which overlaps with the temperature range of the patent. Since the claims in the application with the exception of one limitation are broader than the claims of the patent, a prima facie case of obviousness-type double patenting has been established under a one-way obviousness test with respect to these more narrow limitations. Regarding the overlapping temperature ranges, a prima facie case of obviousness-type double patenting still exists since overlapping ranges create a prima facie case of obviousness (see MPEP 2144.05).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luz L. Alejandro whose telephone number is 305-4545. The examiner can normally be reached on Monday-Thursday from 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills, can be reached on 308-1633. The fax phone numbers for the organization where this application or proceeding is assigned are 872-9310 for regular communications and 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.


Luz L. Alejandro
Patent Examiner
Art Unit 1763

March 9, 2002